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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,157	04/19/2004	Susan M. Britton	P00949-US-01 (14319.0022)	2706
22446	7590	07/31/2008	EXAMINER	
ICE MILLER LLP ONE AMERICAN SQUARE, SUITE 3100 INDIANAPOLIS, IN 46282-0200			MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,157	Applicant(s) BRITTON, SUSAN M.	
	Examiner SHAHID R. MERCHANT	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2008 has been entered.

Status of Claims

2. This action is in response to the request for continued examination filed on May 15, 2008.

- Claims 1-51 are pending.
- Claims 1-35 have been cancelled.
- Claims 36-51 are new claims.

Response to Arguments

3. Applicant's arguments with respect to claims 36-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 40-43 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 36-39. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

5. Claims 48-51 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 44-47. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 36-51 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has introduced several terms that have no support in the original disclosure like transaction record, security document, first

identifier and second identifier. The previously mentioned terms and limitations constitute new matter. Applicant is advised to point out in the original disclosure where the claimed subject matter appears otherwise the new subject matter should be removed from the claims. Applicant is advised to review section **706.03(o) [R-3] New Matter** of the MPEP.

35 U.S.C. 132. Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. **No amendment shall introduce new matter into the disclosure of the invention.**

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 36-43 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (36-43) are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 36-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Levering et al., U.S. Patent Application Publication 2005/0125316 (see PTO-892, Ref. D) in view of website www.tdcanadatrust.com (hereinafter TD Canada Trust) as evidenced by TD Mutual Funds Download Centre (see PTO-892, Ref. U).

12. As per claim 36, Levering teaches a computer implemented method for use in connection with a transaction with a security, which method comprises the steps of:

storing at least a first and second security documents on a document storage database, wherein each security document describes a security, and wherein each security document comprises of a plurality of parts, wherein each part of the plurality of parts is associated with an identifier (see paragraph 48);

receiving a first transaction record with information regarding an ownership of at least one security by an investor, wherein the first transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping at least one part of the plurality of parts of the first transaction record to at least a first identifier (see paragraphs 50 and 54-55);

determining from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the at least one security document from the document storage database wherein the first part is associated with the first identifier (see paragraph 50);

receiving a second transaction record with information regarding an ownership of at least one security by the investor, wherein the second transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping at least one part of the plurality of parts of the second transaction record to at least a second identifier (see paragraphs 50 and 54-55);

determining from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier (see paragraph 50);

delivering the investor document to the investor (see abstract).

Levering does not explicitly teach selecting the second part of the second security document; selecting the first part of the first security document and combining the selected first part of the first security document and the selected second part of the second security document into an investor document.

TD Canada Trust teaches selecting the second part of the second security document; selecting the first part of the first security document and combining the selected first part of the first security document and the selected second part of the

second security document into an investor document (see Ref. U on top of page 3). TD Canada Trust shows how an investor or user can easily select and download Part A and/or Part B of a mutual fund prospectus.

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

13. As per claim 37, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the security document is a prospectus and wherein the identifier is a security identifier or a trade identifier (see paragraph 4).

14. As per claim 38, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the first security document and the second security document are from different issuers (see paragraph 4).

15. As per claim 39, Levering and TD Canada Trust teach the method of claim 36 as described above. TD Canada Trust teaches wherein the investor document further comprising of at least one part of the first transaction record and at least one part of the second transaction record (see Ref. U on top of page 3).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus comprising a first

Art Unit: 3692

transaction and a second transaction because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

16. Claim 40 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.

17. Claim 41 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.

18. Claim 42 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.

19. Claim 43 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

20. Claim 44 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.

21. Claim 45 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.

22. Claim 46 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.

23. Claim 47 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

24. Claim 48 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.

25. Claim 49 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.

Art Unit: 3692

26. Claim 50 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.

27. Claim 51 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

/Kambiz Abdi/
Supervisory Patent Examiner,
Art Unit 3692